

Notice of Allowability

Application No.

10/733,278

Examiner

Brian J. Davis

Applicant(s)

LEININGER ET AL

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 1-20.
3. ☒ The drawings filed on 10 May 2004 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/12/03;10/12/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date ____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

DETAILED ACTION

Information Disclosure Statement

The lined-through entry (EP 0 534 040) on the 12/12/03 IDS is incorrect. That patent is drawn to a method and apparatus for screening granular materials. This is clearly not germane to the instant invention. The correct patent (EP 0 564 040) has been made of record on PTO form 892. (The EP 0 564 040 was the patent supplied by applicant along with the IDS.)

Allowable Subject Matter

Claims 1-20 are allowed. The following is an examiner's statement of reasons for allowance:

The key to the instant invention is the work up, specifically the crystallization step used to isolate the product oxime.

As applicant correctly points out on page 3 line 4 of the specification, in the chemical arts pertaining to ammoximations, extractive and/or distillative processes are used in the recovery of the product oxime. Applicant's IDS references are a representative sample of this fact. Yet even the subset of those references that do teach that other methods may be used, for instance: US 4,794,198 column 2 line 5, "...various ways..."; US 4,745,221 column 2 line 28, "...different methods..."; EP 0 735 017 A1 column 7 line, "...any suitable methods..."; EP 0 690 045 A1 page 5 line 55, "...any suitable means..."; or EP 0 208 311 A2 column 2 line 51, "...different

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methods...”, each reference, in both the descriptive text and the examples, teaches *only* extractions and/or distillations.

Base upon the above, i.e. that the prior art is teaching exclusively towards extraction and/or distillation, and that even the prior art that does teach that other methods may be used doesn't use them, one of ordinary skill in the art would reasonable conclude that the art was teaching away from any method that did not involve an extraction or distillation.

At best, it might have been obvious to try a crystallization step in order to isolate the product oxime, however, an 'obvious to try' standard is impermissible in two situations: 1) where the prior art gives no indication as to which of numerous parameters are critical, or gives no indication as to which of many possible choices is likely to be successful; and 2) where the prior art gives only general guidance with respect to the form of the invention but not how to achieve it new areas of technology or in fields of experimentation which are only seemingly promising. *In re O'Farrell*, 853 F2d 894, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). In the instant case, both 1) and 2) above apply.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
March 18, 2005